

## REMARKS

In the Office Action the Examiner noted that claims 1-9, 11-24, 35, 36, and 41-94 are pending in the application. The Examiner rejected claims 1-9, 11-16, 19, 21, 23, 24, 35, 36, 41-54, 58-75, 78, 80, 82 and 84-94, and objected to claims 17, 18, 20, 22, 55-57, 76, 77, 79, 81 and 83. The Examiner's rejections are traversed below, and reconsideration of all rejected claims is respectfully requested.

### Claim Rejections Under 35 USC §102

In items 2-3 on pages 2-4 of the Office Action the Examiner rejected claims 1, 5, 7, 8, 11, 15, 16, 35 and 36 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,370,090, issued to Verbakel et al. (hereinafter referred to as "Verbakel").

Claim 1 of the present application recites:

An optical recording medium comprising:  
a read-only storage area;  
a non-magnetic writable storage area;  
a read-only lead-in area having first control information for both the read-only and non-magnetic writable storage areas; and  
a non-magnetic writable lead-in area having second control information relating to the non-magnetic writable storage area.

Therefore, the optical recording medium comprises both read-only and writable storage areas, with "a read-only lead-in area having first control information for both the read-only and non-magnetic writable storage areas" and "a non-magnetic writable lead-in area having second control information relating to the non-magnetic writable storage area." The Applicant respectfully submits that the read-only and writable areas of claim 1 of the present application are not disclosed by Verbakel.

The Examiner states that Verbakel discloses "a read-only storage area 120, 122 and 124 (Fig. 5; an area containing a file system 122 and a master TOC are read-only)." The Examiner further states that Verbakel discloses "a non-magnetic writable storage area 126 (Fig. 6; the non-magnetic recording medium 11 is a CD-R, CD-RW etc.; column 2, lines 1-4; area 126 is writable where audio information is written)." The Applicant respectfully disagrees with the Examiner's reading of Verbakel.

Verbakel discloses "an audio management system to allow a user to access various audio track areas in a fast and easy manner" (Column 1, Lines 32-35). This system allows a file system or Master Table of Contents (TOC) to contain information about sub-TOC's that contain information about different audio tracks, such as two channel stereo data or higher

multiples (5-6) of channel data (Column 4, Lines 48-58). However, Verbakel does not disclose providing this file system or Master Table of Contents on a read-only basis, while providing the sub-TOC's and further audio information on a writable basis.

The Examiner points to Column 2, Lines 1-4 of Verbakel as disclosing that the stereo area 126 of Figure 5 is written in a writable recording medium. However, Verbakel does not disclose having only this portion in a writable recording medium. Rather, the section of Verbakel discussed by the Examiner merely states that the file system and attendant audio files can be provided on either a pre-recorded medium or a writable medium. "The carrier may be an optical disc with a recordable or prerecorded information layer. CD-R, CD-RW and DVD-RAM are recordable discs. Audio CD is a prerecorded disc" (Column 2, Lines 4) (emphasis added). It is obvious that Verbakel is merely disclosing that the file system and audio files can be recorded on either the read-only or writable discs, not that the audio files themselves are recorded on a writable portion of a disc while the file system is recorded on a read-only portion.

Further support for the Applicant's assertion is found in Column 2, Lines 22-26 of Verbakel:

The carrier will also contain access information to identify the items, such as a Table of Contents (TOC) or a file system like ISO 9660 for CD-ROM. The access information may include playing time and start address for each item, and further information like a song title.

Therefore, file system or TOC would have to be updated to include the data regarding playing time, start addresses, and song titles for the various audio tracks that would be added if the recording medium were a writable medium, and therefore would also have to be included on the writable medium. In other words, the file system or TOC would have to be on the same type of medium as the audio tracks themselves, i.e., either a read-only or a writable medium. As the file system or TOC would be located on the same type of medium as the audio tracks, the whole recording medium shown in Figure 5 would have to either be a read-only medium, or a writable medium in which the lead-in area contains no more than a lead-in area in any conventional writable recording medium. As the recording medium of Figure 5 is either a read-only or a writable medium, the medium does not disclose the read-only storage area and non-magnetic writable storage area recited in claim 1 of the present application.

Therefore, Verbakel does not disclose the feature of both read-only and writable storage areas, with "a read-only lead-in area having first control information for both the read-only and non-magnetic writable storage areas" and "a non-magnetic writable lead-in area having second control information relating to the non-magnetic writable storage area." Accordingly, Verbakel does not disclose every element of the Applicant's claim 1. In order for

a reference to anticipate a claim, the reference must teach each and every element of the claim (MPEP §2131). Therefore, since Verbakel does not teach the features recited in independent claim 1, as stated above, it is respectfully submitted that claim 1 patentably distinguishes over Verbakel, and withdrawal of the §102(e) rejection is earnestly and respectfully solicited.

Claims 5, 7, 8, 11, 15, and 16 depend from claim 1 and include all of the features of that claim plus additional features which are not taught or suggested by Verbakel. Therefore, it is respectfully submitted that claims 5, 7, 8, 11, 15, and 16 also patentably distinguish over Verbakel.

Claim 35 of the present application recites "a read-only storage area at an inner part of the optical recording medium; and a non-magnetic writable storage area at an outer part of the optical recording medium, wherein the read-only storage area comprises a lead-in area having first control information for both the read-only and non-magnetic writable storage areas, and the non-magnetic writable storage area comprises a lead-in area having second control information relating to the non-magnetic writable storage area." Therefore, the Applicant respectfully submits that claim 35 also patentably distinguishes over Verbakel.

Claim 36 depends from claim 35 and includes all of the features of that claim plus additional features which are not taught or suggested by Verbakel. Therefore, it is respectfully submitted that claim 36 also patentably distinguishes over Verbakel.

In item 4 on page 5 the Examiner rejected claims 41 and 42 under 35 U.S.C. §102(e) as being anticipated by Verbakel.

Claim 41 of the present application recites "a read-only storage area having a lead-in area and a data area; and a non-magnetic writable storage area having a lead-in area and a data area, wherein the lead-in area of read-only storage area comprises physical format information for the read-only storage area and the non-magnetic writable storage." As discussed earlier in this response, Verbakel does not disclose a read-only storage area and a non-magnetic writable storage area. Therefore, the Applicant respectfully submits that claim 41 also patentably distinguishes over Verbakel.

Claim 42 depends from claim 41 and includes all of the features of that claim plus additional features which are not taught or suggested by Verbakel. Therefore, it is respectfully submitted that claim 42 also patentably distinguishes over Verbakel.

In items 5-6 on pages 6-9 the Examiner rejected claims 45, 46, 48, 51-54, 63, 64, 66-68, and 72-75 under 35 U.S.C. §102(e) as being anticipated by Verbakel.

Claim 45 of the present application recites "a system controller which generates

identification information to indicate that the optical recording medium is a hybrid disc having the read-only storage area and the non-magnetic writable storage area." As stated previously in this response, Verbakel does not disclose a recording medium with these features, and similarly does not disclose an apparatus equipped with such a system controller such as recited in claim 45. Therefore, the Applicant respectfully submits that claim 45 also patentably distinguishes over Verbakel.

Claims 46, 48, 51-54, and 63-64 depend from claim 45 and include all of the features of that claim plus additional features which are not taught or suggested by Verbakel. Therefore, it is respectfully submitted that claims 48, 51-54, and 63-64 also patentably distinguish over Verbakel.

Claim 66 of the present application recites a method of recording and reproducing data onto/from an optical recording medium including "generating identification information to indicate that the optical recording medium is a hybrid disc having the read-only storage area and the non-magnetic writable storage area." As stated previously in this response, Verbakel does not disclose a recording medium with these features, and similarly does not disclose a method of recording/reproducing data that generates information applicable to this recording medium. Therefore, the Applicant respectfully submits that claim 66 also patentably distinguishes over Verbakel.

Claims 67-68 and 72-75 depend from claim 66 and include all of the features of that claim plus additional features which are not taught or suggested by Verbakel. Therefore, it is respectfully submitted that claims 67-68 and 72-75 also patentably distinguish over Verbakel.

In item 7 on page 10 the Examiner rejected claim 65 under 35 U.S.C. §102(e) as being anticipated by Verbakel.

Claim 65 of the present application recites "a reproducing unit which reproduces data from the read-only storage area and the non-magnetic writable storage area; and a system controller which controls a reference linear velocity of the reproducing unit for reproduction of the data in the read-only storage area to be the same as a reference linear velocity for reproduction of the data in an innermost part of the non-magnetic writable storage area." As stated previously in this response, Verbakel does not disclose a recording medium with these features, and similarly does not disclose an apparatus equipped with such a reproducing unit or system controller such as recited in claim 45. Therefore, the Applicant respectfully submits that claim 65 patentably distinguishes over Verbakel.

In item 8 on pages 11-12 the Examiner rejected claims 84-87 and 90 under 35 U.S.C. §102(e) as being anticipated by Verbakel.

Claim 84 of the present application recites a method including "reproducing data from an optical recording medium having a read-only storage area at an inner part of the optical recording medium and a non-magnetic writable storage area at an outer part of the optical recording medium." As stated previously in this response, Verbakel does not disclose a recording medium with these features, and similarly does not disclose a method of reproducing data from this recording medium. Therefore, the Applicant respectfully submits that claim 84 also patentably distinguishes over Verbakel.

Claims 85-87 and 90 depend from claim 84. Therefore, it is respectfully submitted that claims 85-87 and 90 also patentably distinguish over Verbakel.

In item 9 on page 13 the Examiner rejected claim 92 under 35 U.S.C. §102(e) as being anticipated by Verbakel.

Claim 92 of the present application recites a method of controlling a DVD-RAM area of an optical recording medium having a DVD-ROM area in an inner part and the DVD-RAM area in an outer part of the optical recording medium, including "reading the first control information from the lead-in area of the DVD-ROM area; and controlling the data in the DVD-ROM area and the DVD-RAM area based upon the read first control information." Verbakel does not disclose an optical recording medium having a DVD-ROM and DVD-RAM area such as this, nor a method of reading and controlling the information contained thereon. Therefore, the Applicant respectfully submits that claim 92 also patentably distinguishes over Verbakel.

#### Claim Rejections Under 35 USC §103

In item 11 on pages 14-16 the Examiner rejected claims 2, 3 and 9 under 35 U.S.C. §103(a) as being unpatentable over Verbakel in view of U.S. Patent No. 6,466,735, issued to Kozuka et al. (hereinafter referred to as "Kozuka").

As discussed in the previous section, claim 1 patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Kozuka. Claims 2, 3, and 9 depend from claim 1 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. For a proper §103 rejection, the cited references must combine to teach all of the features of the application at issue. Therefore, it is respectfully submitted that claims 2, 3, and 9 patentably distinguish over the cited references, and withdrawal of the §103 rejection is requested.

In item 12 on pages 16-17 the Examiner rejected claims 4, 6, 19, and 21 under 35 U.S.C. §103(a) as being unpatentable over Verbakel in view of Kozuka.

As discussed in the previous section, claim 1 patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Kozuka. Claims 4, 6, 19, and 21 depend from claim 1 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Thus, it is respectfully submitted that claims 6, 6, 19, and 21 also patentably distinguish over the cited references.

In item 13 on page 18 the Examiner rejected claims 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over Verbakel in view of Kozuka.

As discussed in the previous section, claim 1 patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Kozuka. Claims 12 and 13 depend from claim 1 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Thus, it is respectfully submitted that claims 12 and 13 also patentably distinguish over the cited references.

In item 14 on page 19 of the Office Action the Examiner rejected claim 14 under 35 U.S.C. §103(a) as being unpatentable over Verbakel.

As discussed in the previous section, claim 1 patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Kozuka. Claim 14 depends from claim 1 and includes all of the features of that claim plus additional features which are not taught or suggested by the cited references. Thus, it is respectfully submitted that claim 14 also patentably distinguishes over the cited references.

In item 15 on pages 20-21, the Examiner rejected claims 58 and 59 under 35 U.S.C. §103(a) as being unpatentable over Verbakel in view of Kozuka.

As discussed in the previous section, claim 45 patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Kozuka. Claims 58 and 59 depend from claim 45 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Thus, it is respectfully submitted that claims 58 and 59 also patentably distinguish over the cited references.

In item 16 on pages 22-23 of the Office Action the Examiner rejected claims 23 and 24 under 35 U.S.C. §103(a) as being unpatentable over Verbakel in view of U.S. Patent 6,243,338, issued to Mine (hereinafter referred to as "Mine").

As discussed in the previous section, claim 1 patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Mine. Claims 23 and 24 depend from claim 1 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Thus, it is respectfully submitted that claims 23 and 24 also patentably distinguish over the cited references.

In item 17 on pages 23-24 the Examiner rejected claims 43 and 44 under 35 U.S.C. §103(a) as being unpatentable over Verbakel in view of Kozuka and Mine.

As discussed in the previous section, claim 41 patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Kozuka and/or Mine. Claims 43 and 44 depend from claim 41 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Thus, it is respectfully submitted that claims 43 and 44 also patentably distinguish over the cited references.

In items 18-19 on pages 25-26 of the Office Action the Examiner rejected claims 47, 49, 61, 62, 70, 82, 88, and 91 under 35 U.S.C. §103(a) as being unpatentable over Verbakel in view of Mine.

As discussed in the previous section, claim 45 patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Mine. Claims 47, 49, 61, and 62 depend from claim 45 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Thus, it is respectfully submitted that claims 47, 49, 61, and 62 also patentably distinguish over the cited references.

As also discussed in the previous section, claim 66 patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Mine. Claims 70 and 82 depend from claim 66 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Thus, it is respectfully submitted that claims 70 and 82 also patentably distinguish over the cited references.

As also discussed in the previous section, claim 84 patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Mine. Claims 88 and 91 depend from claim 84 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Thus, it is respectfully submitted that claims 88 and 91 also patentably distinguish over the cited references.

In items 20-21 on pages 27-28 the Examiner rejected claims 50 and 71 under 35 U.S.C. §103(a) as being unpatentable over Verbakel in view of Kozuka.

Claim 50 depends from claim 45, and claim 71 depends from claim 66. Claims 45 and 66 patentably distinguish over Verbakel, and the deficiencies of Verbakel are not cured by Kozuka. Therefore, it is respectfully submitted that claims 50 and 71 also patentably distinguish over the cited references.

In items 22-23 on pages 28-29 the Examiner rejected claims 60, 78, 80 and 89 under 35 U.S.C. §103(a) as being unpatentable over Verbakel in view of Kozuka.

Claim 60 depends from claim 45, claims 78 and 80 depend from claim 66, and claim 89 depends from claim 84. Claims 45, 66, and 84 patentably distinguish over Verbakel, and the deficiencies of Verbakel are not cured by Kozuka. Therefore, it is respectfully submitted that claims 60, 78, 80, and 89 also patentably distinguish over the cited references.

In item 24 on pages 29-30 the Examiner rejected claim 69 under 35 U.S.C. §103(a) as being unpatentable over Verbakel in view of Mine.

Claim 69 depends from claim 66, which patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Mine. Therefore, it is respectfully submitted that claim 69 also patentably distinguishes over the cited references.

In item 25 on pages 30-31 the Examiner rejected claim 93 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,537,387, issued to Ando et al. (hereinafter "Ando") in view of Kozuka.

The Office Action provides no motivation to combine the cited references other than to state, "In order to improve the access time and storage capacity of Ando's recording medium, it would have been obvious...., because the replaced DVD type recording medium has advantages of fast access time and large storage capacity over the original CD type recording medium." However, "rejection of patent application for obviousness under 35 USC §103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record." In re Lee 61 USPQ2d 1430 (CA FC 2002)

Thus, as pointed out in In re Lee, the record must support motivation, i.e., there must be something in the record pointing out where the recited motivation can be found. In addition, there must be some discussion on how that purported motivation or suggestion is even relevant to the reference being modified.

Although the Examiner cites a CD recording medium, Ando actually discloses a magneto-optical disc having a read-only area and a magneto-optical writable area located outside the read-only area. A magneto-optical disc such as the one discussed in Ando is housed in a protective cartridge to protect the disc, with a sliding access cover on the protective cartridge so that an apparatus to read/write data from/to the magneto-optical disc must be equipped to both accommodate the protective cartridge as well as open the sliding access cover to gain access to the magneto-optical disc. In other words, the magneto-optical disc is used in a very different manner, and with very different devices than the DVD type



discs discussed in Kozuka. As a DVD and a magneto-optical disc are two different areas of technology requiring different equipment to either read data from or write data to the respective discs, the Applicant respectfully submits that there is no motivation to combine the two cited references. Therefore, even if the two references combined did teach or suggest all of the features recited in the present application, and the Applicant respectfully submits that they do not, there is no motivation to combine the two references to achieve the features recited in the present application, and the Applicant respectfully requests the §103(a) rejection of claim 93 be withdrawn.

In item 26 on pages 32-33 the Examiner rejected claim 94 under 35 U.S.C. §103(a) as being unpatentable over Ando in view of U.S. Patent No. 6,466,735, issued to Kotuku et al. (hereinafter referred to as "Kotuku") and Mine.

Claim 94 depends from claim 93 and includes all of the features of that claim plus additional features which are not taught or suggested by Ando. Further, the deficiencies of Ando are not cured by Mine and/or Kotuku. Therefore, it is respectfully submitted that claim 94 also patentably distinguishes over the cited references.

#### Allowable Subject Matter

In items 27-28 on pages 33-34 the Examiner objected to claims 17, 18, 20, 22, 55-57, 76, 77, 79, 81 and 83 as being dependent upon rejected base claims, but indicated that they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As previously discussed, the independent claims upon which these claims depend all patentably distinguish over Verbakel and any other cited references. Therefore, it is respectfully submitted that claims 17, 18, 20, 22, 55-57, 76, 77, 79, 81 and 83 also patentably distinguish over the cited references, and withdrawal of the objection to these claims is respectfully requested.

#### Summary

It is respectfully submitted that none of the references, either taken alone or in combination, disclose the present claimed invention. There being no further outstanding objections or rejections, it is respectfully submitted that claims 1-9, 11-24, 35, 36, and 41-94 are in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Response, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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